

REMARKS

I. Status of Claims

In the September 8, 2003 Final Office action, the Examiner rejected claims 1-20 and 23-29. In order to expedite prosecution of this case, Applicants have amended, without prejudice or disclaimer, independent claims 1 and 20. Applicants added claims 30-31. Applicants have also cancelled claims 6-19 and 26-29 without prejudice to filing one or more applications having similar claims. Support for the various amendments may be found in the originally filed specification, claims and figures; no new matter has been introduced. After entry of the foregoing amendments, claims 1-5, 20, 23-25, 30-31 (2 independent claims) remain pending in the application. Reconsideration is respectfully requested.

II. Rejection of Claims 20, 23-27 and 29 Under 35 U.S.C. Section 103(a).

In the January 16, 2003 Office action, the Examiner rejected claims 20, 23-27, and 29 under 35 U.S.C. 103(a) as being unpatentable over Masaki, Japanese Patent No. 09-244,385 (hereinafter "Masaki"), in view of Gunn, U.S. Patent No. 5,308,121 (hereinafter "Gunn"). Applicant respectfully traverses this rejection, and for the following reasons, reconsideration is respectfully requested.

Applicants acknowledge that Masaki discloses a card having identification/membership indicia on one side and cash card indicia on the other side. However, the Masaki reference discloses the equipment and processes for printing and creating the card. As such, the Masaki reference does not disclose, teach or suggest the specific application process or data flow of application information used for a consumer to acquire the card. Applicants also acknowledge that Gunn discloses a card which combines membership and credit card services. **However, Applicants' invention is not simply a combined card or the dual functions of a combined card; rather, Applicants' invention specifically focuses on a novel and efficient registration/application process.** As such, to expedite prosecution of this application,

Applicants amended the claims to include numerous additional elements disclosing the back-end functionality and complex hardware and software related to the registration/application process.

Significantly, while the cited prior art discloses cards having multiple features and cards "associated" with numerous services, the cited prior art is completely void of any specific discussion related to the registration/application process for obtaining such multiple use cards. **In this regard, Applicants request the Examiner to cite specific disclosure in any of the cited references which discusses the specific registration/application process for a multiple use card, and particularly, any disclosure which specifically discloses the new claim elements.**

III. Rejection of claims 1-19 under 35 U.S.C. 103(a).

The Examiner next rejected claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,969,318, which issued October 19, 1999 to Mackenthun ("Mackenthun") in view of Gunn and Masuda, U.S. Pat. No. 5,569,897 ("Masuda"). Applicant respectfully traverses this rejection, and for the following reasons, reconsideration is respectfully requested.

The Mackenthun reference is limited to a system which accepts and distributes user personal information to many credit card companies (e.g. card service providers) which in turn create a customized credit card with certain materials and features. The disclosure cited by the Examiner is limited to a system which simply requests and shares demographic personal information (e.g., name, address, phone) with multiple card service providers such that the user does not need to re-enter the same information multiple times in different applications. Specifically, at column 4, lines 25-30, the Mackenthun reference discloses ". . . receives personal information from the card requester that will be made available by the gateway apparatus to all selected card service providers so that the user does not have to enter personal information again for each card service provider during a session." Furthermore, although Mackenthun discloses "service specific data files (SSDF)" and "card specific data files (CSDF)", these data elements merely relate to the type of services and card features offered by credit card companies. In other

words, the Mackenthun reference does not disclose similar "service partner information" in an application as required by the pending claims of the present application. In contrast, the present invention does not share personal information with multiple credit card companies or create customized credit cards. Significantly, the presently claimed invention extracts particular data from the application, then sends only certain portions of the application information to one credit card company, all of which is not disclosed or suggested by Mackenthun.

With regard to the §103 rejections of Claims 1-19, "[i]t is impermissible to first ascertain factually what [Applicants] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct [Applicants'] invention from such prior art." *In re Shuman*, 361 F.2d 1008, 1012 (C.C.P.A. 1996). The present claims, as amended, define an invention that is not obvious over Mackenthun, Gunn, or Masuda, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that teaches, hints, suggests, or discloses the specific combination recited in the claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner because Mackenthun, Gunn and Masuda fail to disclose every element appearing in claims 1-19.

IV. Rejection of claim 28 under 35 U.S.C. 103(a).

In the January 16, 2003 Office action, the Examiner rejected claim 28 under 35 U.S.C. 103(a) as being unpatentable over Masaki as modified by Gunn in view of Blank, U.S. Pat. No. 6,089,611 ("Blank"). For the foregoing reasons, Applicants respectfully traverse the Examiner's grounds for rejection. However, to expedite this application, Applicants cancelled claim 28 without prejudice, so the rejection is now moot.

Conclusion

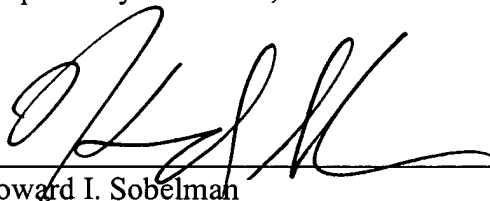
In view of the foregoing, Applicants respectfully submit that all of the pending claims fully comply with 35 U.S.C. Section 112 and are allowable over the prior art of record. Accordingly, reconsideration of the application and allowance of all pending claims is earnestly solicited. The undersigned would welcome a telephone call at the telephone number listed below if such would advance prosecution of this application.

Respectfully submitted,

Date: _____

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By: _____



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